

**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

ELLUL, MARIA D., et al.

Appln. No.: 08/780,507

Confirmation No.: Unknown

**RECEIVED**

NOV 15 2001

**TC 1700**

Group Art Unit: 1713

Examiner: F. ZITOMER

#12

Filed: January 08, 1997

For: TRANSLUCENT THERMOPLASTIC ELASTOMERS

**REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

This Reply Brief is submitted in response to the Examiner's Answer dated September 11, 2001.

In the last paragraph on page 4 of the Examiner's Answer, the Examiner emphasizes through underlining, that in the Examiner's opinion, the Appellants' assertion that the syndiotactic pentads of Masuda are inherent would be persuasive only if the polymers in the parent applications were limited to polypropylenes containing said pentads. In reply, Appellants must submit that the issue of inherency is considered in relationship to the claims on appeal. Three claims are on appeal, which are claims 17, 18, and 19 as set forth in the Appendix to the Brief on Appeal. Each of these claims is directed to a very specific composition which is disclosed as an Example in the application on appeal as well as in all of Appellants' prior applications. The only point of contention is that prior to the filing of the Continuation -in-Part application on appeal, the syndiotactic pentad fraction of the polypropylene of the specific

REPLY BRIEF  
APPLN. NO. 08/780,507

composition disclosed in all parent applications was not explicitly recited. However, the polypropylene was sufficiently identified by its source as to be described as a single material. Thus, the single material of polypropylene possessed a syndiotactic pentad fraction, now explicitly recited. The syndiotactic pentad fraction value, without question, was inherent in the polypropylene itself. It was only necessary to either ask the manufacturer of the value or to analyze for the value. So it is correct to state that from the standpoint of the claimed subject matter, the polymer of the claims is limited to a polypropylene having the recited pentad fraction. From this, Appellants must respectfully submit that the Examiner's assertion is incorrect because the Examiner is considering a perceived generic disclosure, instead of considering the precise subject matter of the three claims on appeal.

The Examiner continues in the last paragraph on page 4 of the Examiner's Answer to state that inherency is not an issue because there is no assurance that all of polypropylene homopolymers of the parent applications would contain the claimed pentads. Again, the Examiner is missing the point. What must be analyzed is what is set forth in the claims on appeal. Once this distinction is understood, it is believed that the Examiner must acknowledge that the propylene homopolymer set forth in each of claims 17, 18, and 19, being that of a precise example in the application as filed and in every parent application as filed, does inherently have a specific pentad fraction, as set forth in each of claims 17, 18, and 19. Inherency is most certainly an issue, and there is assurance that the specific propylene homopolymer of each of claims 17, 18, and 19 does contain the recited syndiotactic pentad fraction of 0.86.

REPLY BRIEF  
APPLN. NO. 08/780,507

On page 5 of the Examiner's Answer, the Examiner cites the case law cited by Appellant in support of Appellants' inherency position. The Examiner submits that the case law is not pertinent to the present case because in the applications being considered before both tribunals, the invention being claimed was limited to only a single structure, that is, the Examiner states that all species disclosed would necessarily contain the structure. The Examiner submits that this is a difference between the cases relied upon and the present case, wherein in the latter, according to the Examiner, the parent applications encompass many structures.

Although Appellants respectfully submit that the Examiner is incorrect in the legal conclusion alleged to be drawn from the case law, the Examiner should note that in the present instance, each of the syndiotactic propylene homopolymers disclosed, that is each species disclosed, has a syndiotactic pentad fraction of 0.86 or 0.87. The species having the syndiotactic pentad fraction of 0.86 is that which is used in the examples recited in the three claims on appeal. Thus, since a pentad fraction of 0.87 or 0.86 could be used within the scope of the disclosed invention, including the invention of Masuda, it would be proper to state that all species disclosed in Appellants application on appeal as well as parents thereof, do describe a single structure.

Furthermore, the Examiner is simply wrong based on the facts set forth in at least the Kennecott Corp. case under consideration.

In Kennecott Corp., the patent at issue was U.S. 4,179,299, copy enclosed. The patentee added to the claims of the '299 patent the statement that the sintered ceramic body has a

REPLY BRIEF  
APPLN. NO. 08/780,507

predominately equiaxed microstructure. As depicted under "Related U.S. Application Data," the '299 patent was a continuation-in-part of an earlier serial number 584,226. The 584,226 application eventually issued as U.S. 4,312,954. This is the '954 application referred to in the Kennecott decision. A page 4, the court found that inherency was based on examples 1-30 of the '954 patent because these were the examples that used high-alpha silicon carbide, which provided the equiaxed microstructure. Upon inspection of the '954 patent, also enclosed, it is seen that 35 examples are provided therein. Thus, not all examples, or species, of the parent application were relied upon to inherently support the subject matter of the claims.

In summary, Appellants respectfully submit that once the analysis is made of the subject matter being claimed in comparison with the disclosure in Appellants' parent applications, a question no longer exists of Appellants' relied upon inherency under the case law of Kennecott Corp. and Nathan. Appellants' claims 17-19 are directed to three very specific compositions exactly described in each of Appellants' applications and in which a particular homopolymer is used, this propylene homopolymer having the syndiotactic pentad fraction of 0.86.

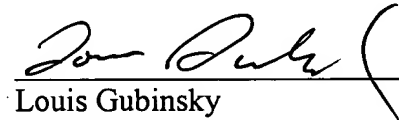
Appellants respectfully request the Examiner to reconsider his position and to either indicate allowability of Appellants' claims since the subject matter thereof has an effective filing date prior to that of Masuda, or to institute an interference.

REPLY BRIEF  
APPLN. NO. 08/780,507

**CONCLUSION**

For the above reasons as well as the reasons set forth in Appellants' Brief on Appeal, Appellants respectfully request that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

  
Louis Gubinsky  
Registration No. 24,835

SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, D.C. 20037-3213  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

Date: November 13, 2001